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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): YOR920000555US1

I hereby certify that this correspondence is being transmitted by facsimile transmission to: Examiner Jacob Lipman, Art Unit 2134, U.S. Patent and Trademark Office, Alexandria, VA 22313-1450, Facsimile No. 571-273-8300, on April 20, 2006.

Rosalind Q. Spiller

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Application Number	Filed
09/751,069	12/29/2000

First Named Inventor: Ravindra R. Mantena

Art Unit	Examiner
2134	Lipman, Jacob

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record.
Registration number 36,650

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Wayne F. R

Signature

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Typed or printed name

518-452-5600

Telephone number

April 20, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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YOR920000555US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Mantena et al.	Confirmation No.:	9009
Serial No.:	09/751,069	Group Art Unit:	2134
Filed:	12/29/2000	Examiner:	Lipman, Jacob

Title: METHOD, SYSTEM AND PROGRAM PRODUCT FOR SYNCHRONOUS COMMUNICATION BETWEEN A PUBLIC ELECTRONIC ENVIRONMENT AND A PRIVATE ELECTRONIC ENVIRONMENT

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted by facsimile transmission to: Examiner Jacob Lipman, Group Art Unit 2134, United States Patent and Trademark Office, Alexandria, VA 22313-1450, Facsimile No. 571-273-8300, on April 20, 2006.

Rosalind Q. Spiller

Rosalind Q. Spiller

Date of Signature: April 20, 2006.

To: Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST

Dear Sir:

In response to a final Office Action with a mailing date of December 20, 2005, response to which was filed within two months of the final Office Action mailing date, and in light of an Advisory Action received with a mailing date of March 15, 2006, and the enclosed Combined Notice of Appeal from the Primary Examiner to the Board of Patent Appeals and Interferences & Petition for Extension Of Time and payment therefor, kindly consider the following remarks in support of the Pre-Appeal Brief Request for Review filed herewith.

REMARKS

Claims 1-84 were originally presented in the subject application. Claims 3, 11, 16, 31, 39, 44, 59, 67 and 72 were amended, and claims 85-112 added in an Amendment and Response to Office Action dated November 17, 2004. Claims 1, 29, 57 and 85 were amended in an Amendment and Response to Office Action dated April 28, 2005. Claims 1, 29, 57 and 85 were amended in an Amendment and Response to Office Action dated November 28, 2005. No claims have herein been amended, added or canceled. Therefore, claims 1-112 remain in this case.

Applicants respectfully request entry of these remarks, and reconsideration and withdrawal of the rejection.

35 U.S.C. §102 Rejection

The Office Action rejected claims 1-7, 10, 11, 14-17, 22-27, 29-35, 38, 39, 42-45, 50-55, 57-63, 66, 67, 70-73, 78-83, 85-91, 94, 95, 98-101, and 106-111, under 35 U.S.C. §102(b), as allegedly anticipated by ERPNet, as Dialog File 20, accession No. 02821200. Applicants respectfully, but most strenuously, traverse this rejection.

ERPNet

Claim 1 recites, for example, causing a reply to the communication to be produced within the private electronic environment in real time.

Applicants could find no disclosure, teaching or suggestion in ERPNet of obtaining a reply within a private electronic environment in response to a user communication, or doing so in real time. Applicants point out that the example given for the system in ERPNet is the ordering of an automobile. No reply to the order per se is disclosed; rather, the progress of the order is tracked. Against the real time aspect of claim 1, the final Office Action cites the first paragraph on page two of ERPNet (i.e., paragraph nine of the reference). However, the cited paragraph, in conjunction with the paragraph immediately prior to that cited, actually discusses the order flowing from the front end to the back end (i.e., one way). There is no mention of a reply being produced.

Moreover, Applicants submit that one of ordinary skill in the art would understand what is meant by "real time' in the context of claim 1. As one example, a definition for "real time" from the well-known whatis.com information technology site is given as (hard copy included with response dated February 21, 2006):

> *Real time* is a level of computer responsiveness that a user senses as sufficiently immediate or that enables the computer to keep up with some external process (for example, to present visualizations of the weather as it constantly changes). *Real time* is an adjective pertaining to computers or processes that operate in real time. Real time describes a human rather than a machine sense of time.

The above definition is also consistent with the description of a communication example given in the present application starting at page 8, line 6. See also, for example, page 3, line 16. The Advisory Action alleges indefiniteness of "sufficiently immediate" above. However, Applicants are only citing the definition as an indication of what one of ordinary skill in the art would understand "real time" to mean; it is not a definition from the present application.

Claim 1 also recites, as another example, automatically returning the reply from the private electronic environment to the public electronic environment. Against this aspect of claim 1, the final Office Action cites to paragraph 8 of ERPNet. However, that paragraph discusses parts of the journey *to* the SAP R/3 (back end) system, and not any communication (let alone a reply) from the back end to the front end.

Therefore, Applicants submit that claim 1 cannot be anticipated by, or made obvious over, ERPNet.

Claims 29, 57 and 85 contain a limitation similar to that argued above with respect to claim 1. Therefore, claims 29, 57 and 85 also cannot be anticipated by, or made obvious over, ERPNet.

Applicants submit that the dependent claims are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For example, claim 3 recites messaging middleware causing the ERP application to produce the reply while the front end application and the messaging middleware wait therefore.

Against claim 3, the final Office Action cites to the disclosure of ERPNet regarding MQSeries and MSMQ. However, the mere mention of such applications does not disclose a reply from the ERP application, or messaging middleware causing the same, much less while the front end application and the messaging middleware wait (recall that claim 1 recites the reply is produced in real time).

Therefore, Applicants submit that claim 3 cannot be anticipated by, or made obvious over, ERPNet.

Claims 31, 59 and 87 contain a limitation similar to that argued above with respect to claim 3. Therefore, claims 31, 59 and 87 also cannot be anticipated by, or made obvious over, ERPNet.

As another example, claim 4 recites that the causing further comprises causing by the messaging middleware a command to be issued to the ERP application to trigger production of the reply.

Against claim 4, the final Office Action cites to the disclosure of ERPNet regarding MQSeries and MSMQ. However, the mere mention of such applications does not disclose a command issued from messaging middleware to an ERP application to trigger production of a reply within a private electronic environment in real time.

Therefore, Applicants submit that claim 4 cannot be anticipated by, or made obvious over, ERPNet.

Claims 32, 60 and 88 contain a limitation similar to that argued above with respect to claim 4. Therefore, claims 32, 60 and 88 also cannot be anticipated by, or made obvious over, ERPNet.

As another example, claim 10 recites details regarding forwarding the communication from the hosting server to the messaging middleware, specifying a path through particular components of the messaging middleware.

Against claim 10, the final Office Action cites to paragraph 6 of ERPNet, disclosing a Java-enabled web browser, SAP R/3 and MQSeries or MSMQ. However, the mere mention of MQSeries and MSMQ does not alone disclose the claimed messaging middleware components or the particular flow of communication forwarding between the components.

Therefore, Applicants submit that claim 10 cannot be anticipated by, or made obvious over, ERPNet.

Claims 38, 66 and 94 contain a limitation similar to that argued above with respect to claim 10. Therefore, claims 38, 66 and 94 also cannot be anticipated by, or made obvious over, ERPNet.

As still another example, claim 11 recites generating, forwarding and returning a token identifier to/from particular messaging middleware components. Against claim 11, the final Office Action cites to paragraph 9 of ERPNet, mentioning tracking the automobile order. However, Applicants submit the cited section fails to disclose anything regarding the claimed token identifier or the particular path to/from the messaging middleware components.

Therefore, Applicants submit that claim 11 cannot be anticipated by, or made obvious over, ERPNet.

Claims 39, 67 and 95 contain a limitation similar to that argued above with respect to claim 11. Therefore, claims 39, 67 and 95 also cannot be anticipated by, or made obvious over, ERPNet.

As yet another example, claim 14 recites forwarding the communication between particular messaging middleware components across a firewall. Against claim 14, the final Office Action cites to paragraph 14 of ERPNet. However, the cited section of ERPNet actually discloses a year 2000 firewall to block messages and send them back, the opposite of the claimed forwarding.

Therefore, Applicants submit that claim 14 cannot be anticipated by, or made obvious over, ERPNet.

Claims 42, 70 and 98 contain a limitation similar to that argued above with respect to claim 14. Therefore, claims 42, 70 and 98 also cannot be anticipated by, or made obvious over, ERPNet.

As another example, claim 15 recites, in part, a module within a particular component of the messaging middleware for issuing a command to the ERP application to trigger production of the reply. Against claim 15, the final Office Action cites to paragraph 6 of ERPNet, disclosing a Java-enabled web browser, SAP R/3 and MQSeries or MSMQ. However, the mere mention of MQSeries and MSMQ does not alone disclose the claimed module or the reply-triggering command.

Therefore, Applicants submit that claim 15 cannot be anticipated by, or made obvious over, ERPNet.

Claims 43, 71 and 99 contain a limitation similar to that argued above with respect to claim 15. Therefore, claims 43, 71 and 99 also cannot be anticipated by, or made obvious over, ERPNet.

As still another example, claim 23 recites details regarding the path of the communication to the ERP application, including forwarding to particular components of the messaging middleware. Against claim 23, the final Office Action cites to paragraph 6 of ERPNet, disclosing a Java-enabled web browser, SAP R/3 and MQSeries or MSMQ. However, the mere mention of MQSeries and MSMQ does not alone disclose the claimed messaging middleware components or the particular flow of communication forwarding that is claimed.

Therefore, Applicants submit that claim 23 cannot be anticipated by, or made obvious over, ERPNet.

Claims 51, 79 and 107 contain a limitation similar to that argued above with respect to claim 23. Therefore, claims 51, 79 and 107 also cannot be anticipated by, or made obvious over, ERPNet.

Gralla

The final Office Action also rejected claims 1, 29, 57 and 85 under 35 U.S.C. §102(b), as allegedly anticipated by Gralla, "How the Internet Works." Applicants respectfully, but most strenuously, traverse this rejection.

Amended claim 1 recites, for example, automatically routing a communication from a user in the public electronic environment to the private electronic environment. Against this aspect of claim 1, the final Office Action cites to Gralla at page 263, step 4. However, Applicants submit that the transaction server is referred to in Gralla as "the site's," and the information is said to be sent "from the customer's computer to the ... transaction server ... over the internet ... [and] encrypted[.]" This results in a new inquiry from the transaction server to the credit card company, rather than routing the customer's communication. As shown on pages 262 and 263, the customer fills out an order form, then the transaction server sends a separate request ("OK to Accept?") to the bank to check the validity of the credit card. Thus, Applicants submit that the communication from the user to the transaction server (the order form) is not being routed to a private electronic environment.

In addition, contrary to the allegation in the final Office Action, Applicants submit one of ordinary skill would not view the transaction server as a user. In the Gralla scenario, the user is the customer. Moreover, Applicants submit that the portion of the transaction server actually communicating with the bank is part of a private environment that includes the bank. Applicants submit one of ordinary skill would assume separation of the public and private environments for security, though Gralla is silent on such details. Further, Applicants disagree that the order form is a request for a credit check. The order form is a request for goods or services, carrying with it express or implied permission to check the credit card number being used for payment.

Amended claim 1 also recites, as another example, causing a reply to the communication to be produced within the private electronic environment in real time. Against this aspect of claim 1, the final Office Action cites to Gralla at page 263, step 5. However, Applicants submit what is actually sent from the transaction server to the credit card company is a new inquiry regarding the users credit card number that is generated by the transaction server. Thus, any reply from the credit card company is not a reply to the user communication, but a reply to the newly generated inquiry from the transaction server.

Finally, amended claim 1 also recites automatically returning the reply from the private electronic environment to the public electronic environment. Against this aspect of claim 1, the final Office Action cites to Gralla at page 263, step 6. However, Applicants submit there is no disclosure, teaching or suggestion that the reply from the credit card company goes anywhere but to the transaction server. Thus, even ignoring the fact that the reply is not a reply to the user communication, in any case it is never returned to the public electronic environment, as claimed.

Therefore, Applicants submit that claim 1 cannot be anticipated by, or made obvious over, Gralla.

Claims 29, 57 and 85 contain limitations similar to that argued above with respect to claim 1. Therefore, claims 29, 57 and 85 also cannot be anticipated by, or made obvious over, Gralla.

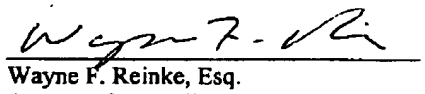
CONCLUSION

Applicants submit that the dependent claims not specifically argued herein are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For all the above reasons, Applicants maintain that the claims of the subject application define patentable subject matter and earnestly allowance of claims 1-112.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,



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Dated: April 20, 2006.

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